

In the outstanding Office Action, the Examiner set forth several reasons why it would have been obvious to modify Satoh et al. to include features of Tanimoto, to disclose the present claimed invention, including the fact that although Satoh et al. fails to disclose a "correspondence or result of the input data in relation to notes" in a table form, it would have been obvious to show the same relationship.

As recently pointed out by the Federal Circuit, "[r]ejection of patent application for obviousness under 35 U.S.C. §103 must be based on evidence comprehended by language of that section, and search for and analysis of prior art includes evidence relevant to finding of whether there is teaching, motivation, or suggestion to select and combine references relied on as evidence of obviousness; factual inquiry whether to combine references must be thorough and searching, based on objective evidence of record." In re Lee 61 USPQ2d 1430 (CA FC 2002)(vacating a decision by The Board of Patent Appeals and Interferences ("Board") of the USPTO, which upheld an examiner's rejection where the motivation for a specific combination was not supported by the record; the vacated holding of Board was based on the premise that "[t]he conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference.")

The outstanding Office Action would appear to essentially rely on the Examiner's own knowledge that one skilled in the art would have been led to modify Satoh et al., as suggested. For example, the Office Action states appear to indicate the motivation for modifying Satoh et al. would be "because Tanimoto provides a clear correlation of input data with stored data including not codes to produce output data." Thereafter, the Examiner merely determines that the modification of Satoh et al. would have therefore been obvious.

However, as noted above, an obviousness determination cannot be based on what the Examiner believes or what the Examiner believes one of common knowledge in the art would have derived from the references.

Conversely, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art..."[the Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." In re Fritch, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992). In addition, the mere fact that the prior art

may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. Id. at 1783-84.

Thus, accordingly, a prima facie obviousness rejection requires evidenced motivation from some reference in the record that would lead one skilled in the art to combine the relevant teachings, again noting that the mere fact that the prior art may be modified in a particular manner does not make the modification obvious unless the prior art suggested the desirability of that modification.

Presently, the outstanding rejection would appear to be inferring from Tanimoto how Satoh et al. could be modified, and thereby determining that such a modification would have been obvious. Thus, the Office Action fails to provide any motivation that would lead one skilled in the art to modify Satoh et al.

Conversely, it would appear that the Examiner is working from what the applicant has invented and building the claimed invention, without such required motivation. See *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983) ("To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.")

Therefore, for at least the above, it is respectfully submitted that the outstanding Office Action has failed to provide a prima facie obviousness case. It is respectfully requested that the outstanding rejections be withdrawn and claims 1-7 be allowed.

## CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

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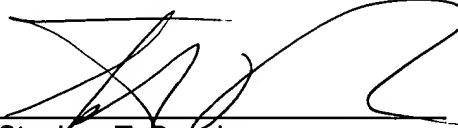
Respectfully submitted,

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